

## REMARKS

### I. Introduction

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

### II. Claim Objections

Claims 37, 49 and 52 are objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claims 13, 15 and 35, respectively. However, as recognized by the Examiner, Applicants respectfully submit that it is only proper, *after allowing one claim*, to object to the other claim as being a substantial duplicate of the allowed claim (see, **M.P.E.P. § 706.03(k)**). As such, because *no* claim has been allowed, it is respectfully submitted that the Examiner's objection to claims 37, 49 and 52 is premature. Please note that Applicants will certainly consider the need for canceling claims 37, 49 and 52 upon allowance of claims 13, 15 and 35.

### III. The Rejection Of Claims 13, 15 and 35-63 Under 35 U.S.C. § 102

Claims 13, 15 and 35-63 are rejected under 35 U.S.C. § 102(a) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over USP No. 6,106,979 to Pierrat. Applicants respectfully traverse this rejection for at least the following reasons.

In the pending rejection, it is alleged that "the [claimed] mask structure appears to have no significant manipulative contribution to the patterning method which comprises the conventional steps as claimed" and "the dependent claims ... do not add to the patterning method which is being claimed." However, Applicants respectfully disagree with the Examiner's conclusion, because *all* the limitations of a claim must be considered when weighing the

differences between the claimed invention and the prior art in determining the *obviousness* of a process or method claim (see, **M.P.E.P. § 2116.01**). The Examiner is directed to **M.P.E.P. § 2116.01** under the section entitled “NOVEL, UNOBVIOUS STARTING MATERIAL OR END PRODUCT,” which sets forth the applicable standard:

“Interpreting the claimed invention as a whole requires consideration of all claim limitations. Thus, proper claim construction *requires* treating language in a process claim which recites the *making or using of a nonobvious product as a material limitation*.”

In addition, the Federal Circuit has stated that a known process can be patented if it is limited to making or using a nonobvious product. *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996). Clearly, this is applicable to the instant case as the photomask recited in the preamble has already been patented by the Applicants. As such, it is respectfully submitted that the claimed novel photomask having the specific structural limitations recited by claim 13 must be considered as a claim element of the rejected method claims. For at least this reason, it is respectfully submitted that the pending rejection is in error.

Furthermore, claim 13 recites in-part that the light shielding pattern is formed from a light-shielding film region formed from a light-shielding film ..., the light shielding pattern includes ... a *first* shielding pattern having a *first* width and a *second* light-shielding pattern having a *second* width larger than the first width.

However, at a minimum, Pierrat is silent with regard to any light-shielding region, let alone disclose a first shielding pattern having a *first width* or a second shielding pattern having a *second width*. In this regard, it is noted that the pending Office Action merely references various portions of Pierrat (e.g., Figs. 5A-5D) as allegedly disclosing all of the claimed features, but does not identify precisely which element (either by reference numerals or by written explanation) of

Pierrat is being read on the respective claimed elements. If any future Office Action is issued, it is respectfully requested that the Examiner identify which specific element of the prior art reads on *each and every* limitation recited in the pending claims so as to allow the Applicants the opportunity to fully respond to the rejection. As Pierrat, at a minimum, fails to disclose the foregoing elements of claim 13, it is respectfully submitted that Pierrat does not anticipate claim 13.

Turning to the obviousness rejection, it is asserted that “[A]ll of the above are results of lithographic process steps of exposing and developing the resist one of ordinary skill in the art would know.”

However, it is respectfully submitted that this “conventional” statement as a prelude to the rejection is not a proper basis for rejecting Applicants’ claims, as the statement is directed to the *Examiner’s opinion* rather than what is taught by the prior art. It is submitted that the “Examiner’s opinion” cannot be relied on to replace the deficiency of a prior art reference. If the pending rejection intended to take Official Notice that the differences between Pierrat and the present invention as recited in the rejected claims are well-known in the art, then pursuant to **M.P.E.P. § 2144.03**, Applicants respectfully traverse such an assertion and request the Examiner to cite one or more references in support of this position (see, second paragraph, last three lines of **M.P.E.P. § 2144.03**, which requires the Examiner to cite a reference in support of his allegation of Official Notice when Applicants traverse).

With respect to claims 35, 37 and 52, as these claims also recite “a photomask,” it is respectfully requested that claims 35, 37 and 52 be allowed for the same reasons discussed above with respect to claim 13.

IV. **All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 13, 35, 37 and 52 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

V. **Conclusion**

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

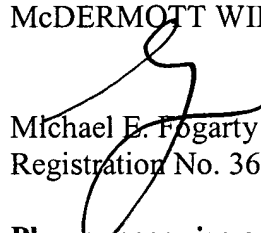
If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

**Application No.: 10/688,960**

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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